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UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
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WASHINGTON, D.C. 20231
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WILLIAM C. GERSTENZANG
NORRIS, MCLAUGHLIN & MARCUS
220 EAST 42ND STREET, 30TH FLOOR
NEW YORK, NY 10017

#22

In re Application of :
Andreas Bleckman et al :
Serial No.: 09/577,294 : PETITION DECISION
Filed: May 23, 2000 :
Attorney Docket No.: BEIERSDORF 614 :

This is a decision on the petition under 37 CFR 1.144, filed November 26, 2002, requesting review of a restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111. The examiner assigned to the application mailed a first Office action to applicants on January 30, 2001, rejecting claims 1-6 for indefiniteness and prior art. Applicants replied on August 3, 2001, amending claims 1-6 and adding claims 7-12. The examiner mailed a Final Office action to applicants on September 10, 2001, maintaining the prior art rejection.

Applicants filed an amendment after Final rejection on February 26, 2002, amending claim 6 and filed a second amendment on the same date amending claim 1. The examiner refused entry of the amendments as raising new issues and not placing the application in better form for appeal. Applicants also filed a Notice of Appeal. On April 6, 2002, applicants filed CPA papers requesting entry of the amendments previously filed.

The examiner mailed a new Office action to applicants on July 2, 2002, setting forth a restriction requirement in the form of an election of species of water soluble substances, lipids, lipophilic components, interface active components and cationic polymers. Applicants replied on July 28, 2002, identifying a species for each element and traversing the requirement as being burdensome on applicants and the public.

The examiner mailed a new Office action to applicants on October 17, 2001, replying to applicants' traversal of the election of species requirement and making it Final. Claims 1-12 were then rejected for obvious double patenting. Claims 1, 4-8 and 10-11 were rejected under 35

U.S.C. 112, second paragraph, for indefiniteness for various reasons. Claims 1, 3-4 and 7-8 were rejected under 35 U.S.C. 103(a) as unpatentable over Fanger et al. Claims 1-2 and 9-10 were rejected under 35 U.S.C. 103(a) as unpatentable over Fanger et al in view of Mahieu et al. Claims 1, 5-6 and 11-12 were rejected under 35 U.S.C. 103(a) as unpatentable over Fanger et al in view of Albacarys et al.

In response, applicants filed this petition of the restriction requirement. Applicants argue that the restriction requirement is improper as examination of the entire application can be done without serious burden to the examiner and that the examiner has not provided evidence of a serious burden. It was also noted that the application was initially examined without a restriction/election of species requirement being made and that no substantive changes to the claims under prosecution have been made which would result in the need for a restriction or election of species requirement. It is also noted that the applications over which an obvious double patenting rejection has been made have not been subject to a restriction or election of species requirement, but have claims of similar scope. Thus prosecution of the three applications is inconsistent.

DISCUSSION

A review of the original claims and those now under consideration as entered after the CPA request was accepted has been made. Other than making minor amendments to each of the four components of the water-in-oil emulsions the only substantive amendment made is to add a specific viscosity/temperature limitation of the emulsion as a whole. Applicants' arguments for withdrawing the restriction and election of species requirement have been carefully considered in light thereof.

Inasmuch as the invention now being claimed is essentially identical to the invention originally claimed, the making of a restriction or election of species requirement after substantial prosecution, but with no significant change to the composition's components without good and sufficient reasons is not indicative of reasonable prosecution on the part of the Office. It is to be presumed that the search and examination of the original claims was sufficiently extensive to uncover the most pertinent prior art for determination of patentability. Having done that there can be no serious new burden placed on the examiner in continuing the examination of claims of comparable scope during later prosecution. The examiner has not sustained the requirement of a serious burden on the Office.


Further, assuming that the claims in copending applications over which an obvious double patenting has been made are of similar scope, consistency of Office practice and prosecution would not sustain making of a restriction or election of species requirement herein. Further, it would appear from a review of the prior art of record that a wide number of examples of each component of the emulsion is disclosed therein, thus further sustaining applicants' argument that there is no additional or significant burden on the examiner.

DECISION

Applicants' petition under 37 CFR 1.144 is **GRANTED**. The restriction/election of species requirement is withdrawn.

Applicants remain under obligation to reply to the Office action mailed October 17, 2002, within the time period set therein or as may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll 
Director, Technology Center 1600